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No. 499

In the

Supreme Court of the United States

OCTOBER TERM, 1965

OUTBOARD MARINE CORPORATION,

Petitioner,

vs.

DONALD A. HOLLEY,

Respondent.

PETITION FOR REHEARING.

S. LAWRENCE WHEELER
ROBERT E. CLEMENCY
WHEELER, WHEELER & WHEELER
606 W. Wisconsin Avenue
Milwaukee, Wisconsin 53203
Attorneys for Petitioner.

The Scheffer Press, Inc., 118 South Clinton Street, Chicago, Illinois

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CERTIFICATE OF COUNSEL

Undersigned counsel hereby states that the accompanying Petition for Rehearing is presented in good faith and not for delay. Counsel further certifies that this Petition is restricted to grounds which are confined to intervening circumstances of substantial or controlling effect, *i.e.*, to the decisions of this Court in each of the cases of *Graham* v. *John Deere Company of Kansas City*, 86 S.Ct. 684, 148 USPQ 459, and *United States* v. *Adams*, 86 S.Ct. 708, 148 USPQ 479.

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S. Lawrence Wheeler

PETITION FOR REHEARING.

This Petition for Rehearing is limited to the single question of obviousness and is based upon the intervening opinions of this Court in the cases of *Graham* v. *John Deere Company of Kansas City*, 86 S.Ct. 684, and *United States* v. *Adams*, 86 S.Ct. 708.

At the very least, your Petitioner submits that the failure of the lower courts in the instant case to apply the criteria enunciated by this Court in the *Graham* and *Adams* cases justifies remand. The lower courts have applied relaxed standards inconsistent with those expressed by this Court in the *Graham* and *Adams* cases, and thereby have worked substantial injustice on the public by withdrawing from the public the unrestricted right to use structures which should be freely available to all.

Inasmuch as all of the facts and arguments bearing on the issue of obviousness are before this Court, and since determination of this single issue will be dispositive, the case might well be reversed outright. In any event, and at the very least for the purpose of remand, reconsideration of Defendant's Petition for a Writ of Certiorari is respectfully requested.

THE APPLICABILITY OF THE GRAHAM CASE

Comparison of the holdings of the trial court, the Appellate Court, and the recent decision of this Court in the Graham case establishes that the standard of patentability applied in the Courts below was in error. In this regard, the statements of the trial court and the Court of Appeals in the instant case and the statements of the Supreme Court in the *Graham* case are quoted below to facilitate comparison.

STANDARD OF PATENTABILITY

Trial Court (this case)	Appellate Court (this case)	Supreme Court (Graham case)
"it appears that by the first sentence Congress intended some *relaxation* of the standards of patentability,"[1] (emphasis supplied)		"We have been urged to find in §103 a *relaxed* standard, • • • The standard has remained *invariable* in this Court."[5] (emphasis supplied)
"the persuasive interpretation of Section 103 is that which attributes to it the expression of congressional desire for some change away from a narrow construction of inventiveness."[2]	"We hold the District Court was correct in concluding that . . . Plaintiff's system was not obvious to others skilled in the trade."[4]	"it bears repeating that we find no change in the general strictness with which the overall test is to be applied."[5]
"it is believed that some modification was intended in the direction of moderating the extreme degrees of strictness exhibited by a number of judicial opinions over the past dozen or more years; that is, *that some change of attitude more favorable to patents was hoped for.*"[3] (emphasis supplied)	"We think the trial court applied the correct legal criteria".[4]	"the revision was not intended by Congress to change the general level of patentable invention."[6]

[1] Appendix filed with Court of Appeals, page 365.
[2] Appendix filed with Court of Appeals, page 366.
[3] Appendix filed with Court of Appeals, page 367.
[4] Petition for a Writ of Certiorari, page A-8.
[5] *Graham* v. *John Deere*, 86 S. Ct. 684, 694; 148 USPQ 459, 467.
[6] *Graham* v. *John Deere*, 86 S. Ct. 684, 693; 148 USPQ 459, 466.

It is respectfully submitted that the relaxed standard applied below was contrary to the strict standard again enunciated by the *Graham* case. Accordingly, it is further respectfully submitted that this error alone constitutes sufficient basis for the granting of the Petition.

Still further, it is respectfully submitted that the Courts below applied, with respect to the issue of obviousness, incorrect criteria in excluding the teachings of the automotive art as applicable to marine engines. The statements of the Trial Court and the Court of Appeals in the instant case, and the statements of the Supreme Court in the *Graham* case, are quoted below to facilitate comparison.

THE OBVIOUSNESS, AS MATTER OF LAW, OF USING AUTOMOTIVE TEACHING IN THE MARINE FIELD

Trial Court (this case)	Appellate Court (this case)	Supreme Court (Graham case)
"It would *not have been obvious* in 1949 to one skilled in this art to have used the *teachings* of the Morgan, Giesler and/or Rayfield patents, either singly or in combination, to make the invention developed by plaintiff."[7] (Emphasis supplied)	"We think the District Court was correct in holding that differences in the operation and purpose between automobile and marine cooling systems, are so substantial that patents cited by defendant pertaining to automotive systems do not anticipate the patent in suit."[8]	"As a member of the patent board for several years, Jefferson saw clearly the difficulty in 'drawing a line between things which are worth to the public the embarassment of an exclusive patent and those which are not.' The board on which he served sought to draw such a line and formulated several rules which are preserved in Jefferson's correspondence.'"[9] "'A machine of which we are possessed might be applied by every man to any use of which it is susceptible.' Letter to Isaac McPherson"[10]

[7] Appendix filed with Court of Appeals, page 405.

[8] Petition for a Writ of Certiorari, page A-6.

[9] *Graham* v. *John Deere*, 86 Ct. 684, 689; 148 USPQ 459, 463.

[10] *Graham* v. *John Deere*, 86 S. Ct. 684, 690; 148 USPQ 459, 464.

Trial Court (this case)	Appellate Court (this case)	Supreme Court (Graham case)
"The Morgan patent No. 2,471,533 is the only patent relied on by defendant which is related to *cooling systems for marine engines.* (As previously noted, the apparatus of the Morgan patent is different than that of the patent in suit and does not negate its validity.) The other patents relied upon by defendant (Giesler and Rayfield) relate to *cooling systems for automotive engines.*" [11] (Emphasis supplied)	"*Claim 3 should be construed as being directed and limited to a cooling system for a marine internal combustion engine having a water jacket.* Defendant cannot properly broaden the claim to encompass the entirely different *automotive internal combustion engine cooling system* of the Giesler and Rayfield patents." [12] (Emphasis supplied)	"Moreover, the ambit of applicable art in given field of science has widened by disciplines unheard of a half-century ago. It is but an even handed application to require those persons granted the benefit of a patent monopoly be charged with an awareness of these changed conditions. The same is true of the less technical, but still useful arts." [13]

It is literally true that the only differentiation of the patented invention from the prior art is found in the preamble to the claim in suit in the words "In a marine engine".[14] There is nothing in the specification of the patent in suit which sets forth any special problem and there is nothing in the language of the single claim in suit which recites in mechanical terms any solution to any such problem.

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[11] Appendix filed with Court of Appeals, page 405.

[12] Petition for a Writ of Certiorari, page A-7.

[13] *Graham* v. *John Deere*, 86 S. Ct. 684, 694; 148 USPQ 459, 467.

[14] The claim in suit is found on Page 3 of the Petition for a Writ of Certiorari.

The Giesler Patent 1,561,153[15] and the Rayfield Patent 1,528,788[16] each include a cooling system having an engine cooling jacket, a bypass, a discharge line, and a valve arranged identically with respect to the engine jacket, bypass, discharge line, and valve included in each of the marine engines disclosed by the Morgan Patent 2,471,533[17] and the Holley Patent 2,536,642.[18] The Giesler and Rayfield valves operate, as do the Morgan and Holley valves, to apportion flow between the cooling jacket and bypass to the discharge line.

The question is therefore squarely presented. As a matter of law, is it obvious to employ in marine practice, structure identically used in automotive practice. To apply the Jeffersonian criteria, the Rayfield and Giesler valves "of which we are possessed might be applied by every man to any use of which it is susceptible.",[19] *i.e.*, to the marine cooling system of Morgan. Your Petitioner therefore respectfully submits that under the *Graham* case, this question should be answered in the affirmative.

OBVIOUSNESS AND THE APPLICABILITY OF THE ADAMS CASE

Nor is the validity of the Holley patent supported by the *United States* v. *Adams* case. As stated in *United States* v. *Adams,* (at 86 S. Ct. 713) "The issue is whether bringing them together . . . was obvious in the light of the

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[15] Petition for a Writ of Certiorari, page A23, see also chart on page A-12.

[16] Petition for a Writ of Certiorari, page A27, see also chart on page A-13.

[17] Petition for a Writ of Certiorari, page A18, see also chart on page A-11.

[18] Petition for a Writ of Certiorari, page A14.

[19] *Graham* v. *John Deere,* 86 S. Ct. 694, 690; 148 USPQ 459, 464.

prior art." As applied to this case, the issue is whether it was obvious to use either of the Giesler or Rayfield valves in the Morgan marine engine cooling system. In the instant case the very factors relied upon by the court in the *Adams* case to uphold the validity of the Adams patent are not only lacking from, but are contrary to, the factors in the instant case. In this regard, various statements of this Court in the *Adams* case are compared below to the applicable factors in the instant case.

The Adams Case	The Present Case
This court found that the claims were valid because the Adams' battery was "shown to embrace elements having an interdependent functional relationship."[20] not found in the prior art patents.	The instant case is exactly opposite. The Giesler and Rayfield patents disclose apportioning valves which are located in identically the same functional relationship to an engine jacket, a bypass, and a discharge line as are the Morgan and Holley valves. Moreover, the Giesler and Rayfield valves function to obtain the identically same end result in the Morgan cooling system and as in the Holley arrangement, *i.e.*, to apportion flow between the bypass and the engine jacket. Since the functional relationship as well as the end result is identical, substitution of either of the Giesler or Rayfield valves in the Morgan marine engine cooling system would produce *no* new result whatever. It is simply an obvious substitution of one valve for another.

[20] *United States* v. *Adams*, 86 S. Ct. 708, 713; 148 USPQ 479, 483.

The Adams Case	The Present Case
In upholding the validity of the Adams' claims, one of the factors which the court referred to was that the Skrivanoff reference "disclosed the use of magnesium in an electro-lyte completely different from that used in Adams."[21]	The Giesler and Rayfield valves are used in engine cooling systems which include an engine jacket, a bypass and discharge pipe arranged in identically the same way as in the prior art marine engine of the Morgan patent and as in the Holley patent.
• • • • •	
This court noted "it is even open to doubt whether cuprous chloride was a functional element in Skrivanoff".[21]	The Rayfield and Giesler valves are clearly functional elements.
• • • • •	
This court held that "the Skrivanoff formulation was both dangerous and inoperable".[21]	Unlike the Adams' case, the Rayfield and Giesler valves are neither dangerous nor inoperable.
• • • • •	
This Court further held "If the use of magnesium for zinc and cuprous chloride for silver chloride were merely equivalent substitutions, it would follow that the resulting device—Adams'—would have equivalent operating characteristics. But it does not.".[21]	Substitution of either of the Giesler or Rayfield valves in place of the Morgan valve in identically the same type of engine water jacket, bypass, and discharge pipe arrangement does not alter the operating characteristics of the Giesler and Rayfield valves. The Giesler or Rayfield valves would operate in the Morgan cooling system in the same manner as in the Giesler or Rayfield patents and in the manner disclosed in Holley. Moreover, such a

[21] *United States* v. *Adams*, 86 S. Ct. 708, 714; 148 USPQ 479, 483.

The Adams Case	The Present Case
	substitution would not alter the end result operating characteristics of the Morgan marine engine cooling system.
• • • • •	
In referring to the prior art references, this Court held "most of the batteries relied upon by the government were of a completely different type".[21]	Unlike the situation in the Adams' case, the general relationship of the valve to the engine water jacket, bypass, and discharge pipe is *identical* in *each* of the Rayfield, Giesler Morgan, and Holley patents. Clearly, the references in this case are not of a "completely different type".
• • • • •	
This Court further held "As we have seen, the operating characteristics of the Adams' battery have been shown to have been unexpected and to have far surpassed then-existing wet batteries."[22]	Substitution of Giesler or Rayfield valves for the Morgan valve would not alter the end result of the Morgan cooling system, *i.e.*, apportionment of flow between the engine water jacket and the bypass in a manner identical to the operation of the Holley arrangement. Moreover, substitution of the Giesler or Rayfield valve in the Morgan marine engine cooling system would not alter the mode of operation of the Giesler or Rayfield valves. There would be no unexpected result.
• • • • •	

[21] *United States* v. *Adams*, 86 S. Ct. 708, 714; 148 USPQ 479, 483.

[22] *United States* v. *Adams*, 86 S. Ct. 708, 714; 148 USPQ 479, 483.

The Adams Case

This Court further held that an invalidating combination of the asserted prior art patents "required that a person reasonably skilled in the prior art must ignore that (1) batteries which continue to operate on an open circuit and which heated in normal use were *not practical;* and (2) water activated batteries were *successful* only when combined with electro-lytes detrimental to the use of magnesium. *These long accepted factors, when taken together, would, we believe, deter any investigation into such a combination as is used by* Adams."[22] (Emphasis supplied)

The Present Case

Unlike the situation in the Adams' case, the prior art devices disclosed by Giesler and Rayfield and Morgan were practical and successful. There is no reason why one would not find the Giesler and Rayfield valves entirely practical and wholly operable in the Morgan marine engine cooling system. The affirmative testimony on this point is undisputed and there is no finding to the contrary.[23]

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[22] *United States* v. *Adams*, 86 S. Ct. 708, 714;148 USPQ 479, 483.

[23] The uncontradicted testimony of Mr. Irgens, an expert in the field, is as follows: (Appendix filed with the Court of Appeals, Page 264):

"Q. Now, if you had the Morgan device as shown in the drawing of Morgan patent, 2,471,533 and wanted to operate both valves directly from the thermostatic wafer instead of operating one indirectly by back pressure, would there be any problem in adapting such a valve as is shown in Giesler 1,561,153, Defendant's Exhibit H?

A. No. The Giesler valve could be substituted for the one shown by Morgan.

Q. Would it involve anything more than making the appropriate piping connections?

A. No."

The Adams Case	The Present Case
This Court also held that "We do say, however, that known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness."[24]	Unlike the prior art references in the Adams' case, there is *no* disadvantage to the valve structures of the Giesler and Rayfield patents which would detract from their substitution in place of the Morgan valve.
• • • • • •	
This Court further held as follows, "Furthermore, in a crowded art replete with a century and a half of advancement, the Patent Office found not one reference to cite against the Adams application."[25]	In the present case, the Patent Office cited the Morgan patent here relied on, but failed to cite either of the Giesler or Rayfield patents which disclose valves producing identically the same end result in identically the same environment as the Morgan valve and in the same manner as in the Holley patent in suit.
• • • • • •	

Your Petitioner therefore respectfully submits that, in accordance with the Adams case, the obviousness of the substitution of either of the Giesler or Rayfield valves in the Morgan cooling system renders the Holley patent invalid.

CONCLUSION

Consonant with this Court's decisions in the Graham and Adams cases, it is respectfully submitted that the decision below is in error because:

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[24] *United States* v. *Adams*, 86 S. Ct. 708, 714; 148 USPQ 479, 484.

[25] *United States* v. *Adams*, 86 S. Ct. 708, 715; 148 USPQ 479, 484.

(a) The lowered standard of patentability applied in the courts below was contrary to the standard earlier enunciated in the A & P case[26] and again reiterated by the *Graham* case, *i.e.*, "the general level of innovation necessary to sustain patentability remains the same."[27]; and

(b) In the present case, the factors which support validity in the Adams case are directly opposite to the factors in the instant case and therefore focus attention on the *obviousness* of the claim here in suit.

As the issue of patentability is an issue of law, it is respectfully submitted that, under the Graham and Adams cases, logic and justice require that the decision below be reversed.

It is therefore respectfully requested that the Court either:

(a) grant the Petition For a Writ of Certiorari; or

(b) remand the case with instructions to the lower courts to apply the proper standards of patentability in the light of this Court's recent decisions in the Graham and Adams cases; or

(c) reverse (since it already has the complete record and the complete issue before it).

Respectfully submitted,

S. Lawrence Wheeler
Robert E. Clemency
Wheeler, Wheeler & Wheeler
606 W. Wisconsin Avenue
Milwaukee, Wisconsin 53203
Attorneys for Petitioner.

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[26] *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp. et al.*, 340 US 147 (1950).

[27] *Graham* v. *John Deere*, 86 S. Ct. 684, 686.